

REMARKS

Claims 1-7 are currently pending in this application. In the Office Action, the Examiner has rejected Claims 1-7 under 35 U.S.C. § 102(e) as being anticipated by *Soliman* (U.S. 6,321,090 B1).

Soliman discloses a mobile communication system with position detection to facilitate hard handoff. Soliman utilizes IS-95A standards to perform its hard handoff as set forth in col. 8, lines 9-22. Soliman clearly states in col. 7, lines 52-67 that the active set of signals that a mobile station must search is a set of signals that contains all of the pilot signals that the mobile unit is currently or potentially demodulating. Therefore, Soliman discloses searching all pilot signals.

Claims 1, 4 and 7 each recite setting an area of services covered with a frequency assignment (FA) of a plurality of FAs of a base station currently engaged in communication with a mobile communication terminal, to be a boundary cell, the FA is only included in FAs of the base station and not in adjacent stations of the base station, and searching FAs of only adjacent stations excluding the base station currently engaged in communication with said mobile communication terminal so as to determine a target FA, with which the mobile communication terminal is to perform the hard hand-off.

On October 17, 2006 a telephonic interview was conducted between Applicant's representative, Michael J. Musella, and the Examiner. During the interview with the Examiner, the Examiner reiterated his position that Soliman anticipates the claims of the present application. The Examiner further explained his position, stating that since Soliman discloses a hard handoff to a target base station, Soliman must therefore be excluding the source base station from the handoff (although not disclosed), and Soliman must therefore search FAs (although not disclosed), and therefore, Soliman must exclude searching FAs of the source base station (although not disclosed). A telephonic interview was then conducted with the Supervisory Patent Examiner (SPE).

The SPE stated that he spoke with the Examiner and determined that although not stated in the Office Action, the Examiner was “probably” relying on the theory of inherency to support his rejection. It was explained to the SPE that none of these features could be supported by an inherency argument. The SPE would not require the Examiner to withdraw the Office Action. It was requested from the SPE that in the event a Response was filed that he closely work with the Examiner in replying thereto; the SPE agreed.

The MPEP §2112 Requirements of Rejection Based on Inherency, subsection IV states that the examiner must provide rationale or evidence tending to show inherency. This section goes on to state:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic...To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient...In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

In addition to the above, the Examiner has chosen to ignore the first clause of the claims that recite setting an area of services covered with a frequency assignment (FA) of a plurality of FAs of a base station currently engaged in communication with a mobile communication terminal, to be a boundary cell; the FA is only included in FAs of the base station and not in adjacent stations of the base station. The Examiner has not provided any citation to reject these features. The Examiner does not respond to the argument supporting these features. It is respectfully requested that the Examiner properly examine these features.

Further, the claims recite setting a boundary cell. Soliman does not set a boundary cell.

Still further, the claims recite that the boundary cell is set up such that the FA is only included in FAs of the base station and not in adjacent stations of the base station. Soliman does not set up boundary cells in this manner.

And further, the claims recite searching FAs. Soliman does not even mention searching FAs.

And still further, the claims recite that the searched FAs are FAs of only adjacent stations excluding the base station currently engaged in communication with said mobile communication terminal so as to determine a target FA. As stated above, Soliman during its base station search, searches all of the base stations, and does not exclude any base stations during its pre-hard handoff search for base stations.

The Examiner makes a statement that is unsupported by the reference to attempt to provide support for his rejection; namely, the Examiner states, "wherein source BST will be excluding when mobile station No. 26 perform hand-off to target BST." Although this may be true, it is not relevant, and not disclosed in the reference. Even if it were disclosed in the reference, which it is not, the fact that a handoff is not performed to a source base station does not change the fact that in these prior art systems the mobile stations still were required to search all frequency assignments prior to handoff. The present invention only searches FAs of only adjacent stations excluding the base station currently engaged in communication with said mobile communication terminal.

Based on at least the foregoing, withdrawal of the rejections of Claims 1, 4 and 7 is respectfully requested.

Based on at least the foregoing, Independent Claims 1, 4 and 7 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2, 3, 5 and 6, these are likewise believed to be allowable by virtue of their dependence on their

respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2, 3, 5 and 6 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-7, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul J. Farrell", written over the printed name.

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